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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,700	02/07/2002	Andrew D. Firlik	337348020US4	2530
25096	7590	12/19/2005	EXAMINER	
PERKINS COIE LLP			BRADFORD, RODERICK D	
PATENT-SEA			ART UNIT	
P.O. BOX 1247			PAPER NUMBER	
SEATTLE, WA 98111-1247			3762	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No.	Applicant(s)	
	10/072,700	FIRLIK ET AL.	
	Examiner	Art Unit	
	Roderick Bradford	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 34-51 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 and 49-51 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43 and 45-48 is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 34-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4 and 34-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Gluckman et al. U.S. Patent No. 6,873,872.

Referring to claims 1 and 34 Gluckman discloses a method of effectuating an neural function in a patient comprising:

- Selecting a stimulation site at the cortex of the patient where a change in neural activity is suspected of occurring to carry out a particular physical function and/or cognitive function of the patient, wherein the intrinsic neural activity arises in association with a naturally occurring physiological process that facilitates at least partial functional recovery following neurological damage (column 10, lines 22-48)

- Positioning an electrode at the selected stimulation site (column 10, lines 31-34)
- Applying an electrical potential to the stimulation site via the electrode (column 10, lines 31-35)

Referring to claim 4, wherein, in a case in which the patient has experienced a stroke at the primary motor cortex in the frontal lobe, the procedure of selecting a stimulation site comprises choosing a stimulation site at the premotor cortex anterior to the stroke in the frontal lobe and the procedure of positioning an electrode comprises placing an electrode at the premotor cortex anterior to the stroke in the frontal lobe (column 10, lines 22-48).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gluckman et al. U.S. Patent No. 6,873,872 in view of Schiff et al. U.S. Patent No. 5,938,688.

Referring to claim 2, Gluckman discloses the claimed invention except for wherein the method further comprises:

- Providing a first listing containing a plurality of physical functions and/or cognitive functions and a second listing containing a plurality of neural-sites in the cortex where neural-activity is suspected to change to carry out a particular one of the physical functions and/or cognitive functions
- Selecting a stimulation site comprises identifying a physical function and/or cognitive function in the first listing that is correlated to an altered function of the patient, and determining a corresponding neural-site in the cortex of the patient in the second listing.

However Schiff discloses:

- Providing a first listing containing a plurality of physical functions and/or cognitive functions and a second listing containing a plurality of neural-sites in the cortex where neural-activity is suspected to change to carry out a particular one of the physical functions and/or cognitive functions (Table 2) as a means to easily identify specific sites of the cortical region that need to be stimulated to produce the desired outcome.

- Selecting a stimulation site comprises identifying a physical function and/or cognitive function in the first listing that is correlated to an altered function of the patient, and determining a corresponding neural-site in the cortex of the patient in the second listing (Table 3) as a means to easily identify specific sites of the cortical region that need to be stimulated to produce the desired outcome.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Gluckman to include providing a first listing containing a plurality of physical functions and/or cognitive functions and a second listing containing a plurality of neural-sites in the cortex where neural-activity is suspected to change to carry out a particular one of the physical functions and/or cognitive functions and selecting a stimulation site comprises identifying a physical function and/or cognitive function in the first listing that is correlated to an altered function of the patient, and determining a corresponding neural-site in the cortex of the patient in the second listing, such as taught by Schiff, as a means to easily identify specific sites of the cortical region that need to be stimulated to produce the desired outcome.

Allowable Subject Matter

2. Claims 43 and 45-48 allowed.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Bradford whose telephone number is (571)

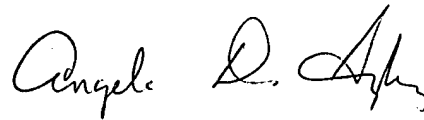
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272-4942. The examiner can normally be reached on Monday - Friday 9 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


R.B.



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